

REMARKS

In the Office Action dated February 22, 2006, claims 1, 3, 4, 11, and 28 were rejected under 35 U.S.C. § 102 over U.S. Patent No. 6,618,499 (Kohler); claims 5-8, 10, 14, 19, 20, and 30 were rejected under § 103 over Kohler in view of U.S. Patent No. 5,751,829 (Ringland); claims 9 and 26 were rejected under § 103 over Kohler in view of U.S. Patent No. 5,528,703 (Lee); claims 12 and 13 were rejected under § 103 over Kohler in view of U.S. Patent No. 5,506,946 (Bar); claim 18 was rejected under § 103 over Kohler in view of Ringland and Lee; claims 21 and 29 were rejected under § 103 over Kohler in view of U.S. Patent No. 6,344,853 (Knight); claims 22-24, 31, and 32 were rejected under § 103 over Kohler in view of Ringland and U.S. Patent No. 5,594,807 (Liu); and claim 27 was rejected under § 103 over Kohler in view of Lee and Knight.

CLAIM 1

Claim 1 has been amended to incorporate the subject matter of dependent claim 21 (now cancelled). The subject matter of former claim 21 was rejected as being obvious over Kohler and Knight. The Office Action stated that Kohler does not disclose sending the identity of the corresponding color to a shopping website for purchasing a product having the corresponding color. 2/22/2006 Office Action at 16. However, the Office Action stated that Knight discloses this claimed feature. *Id.* at 16-17. It is respectfully submitted that the Office Action has failed to establish a *prima facie* case of obviousness for at least the following reasons: (1) no motivation or suggestion existed to combine the teachings of Kohler and Knight; and (2) the hypothetical combination of the references does not teach or suggest all elements of the claim. *See* M.P.E.P. § 2143 (8th ed., Rev. 3), at 2100-135.

Kohler describes a technique that purportedly addresses the issue of different color output devices operating in respective different ranges of colors. Kohler, 1:21-23. A color that lies within a multi-dimensional color space for a first device may be outside the multi-dimensional color space for a second device. Kohler, 1:40-43. Consequently, such a color can be output by the first device, but cannot be output by the second device. Kohler, 1:43-45. Kohler describes a technique in which a color that lies outside the multi-dimensional color space of the second device can be mapped to a color point within the multi-dimensional color space of the second

device. Kohler, 5:30-36; 9:63-10:7. Once mapped, the color can then be provided to the second device, such as a printer, for output (printing). Kohler, 13:5-10.

An output device, such as a printer, can be located over a local area network or the worldwide web. Kohler, 4:61-64. In other words, according to Kohler, once a color is mapped to be within the color space of a particular output device, that color can be provided to such output device (which could be over a network) for output. What Kohler suggests to a person of ordinary skill in the art is that mapping of a color between different color spaces is performed so that such color can be output by a particular output device. It is important to note that there is absolutely no suggestion whatsoever in Kohler of any desirability to send the mapped color to a shopping website, as recited in claim 1.

In attempting to remedy this shortcoming of Kohler with respect to the claimed subject matter, the Office Action attempted to rely upon Knight as providing the requisite suggestion or motivation to modify Kohler to achieve the claimed subject matter. However, Knight clearly does not provide such suggestion or motivation. The Office Action relied specifically on Fig. 3E (154) in column 10, lines 13-18, of Knight as disclosing the sending of the identity of a color over a network to a shopping website for purchasing a product having the corresponding color.

The cited portions of Knight describe a purchaser selecting from among available colors for a selected product. This selection is in the context of the purchaser picking a product and a logo to combine into a common image. *See* Knight, 9:30-10:67. Note that the selection is made by a *purchaser* by *clicking* on one of several keys (154a-154e) shown in the web page of Figure 3E of Knight. A user *manually* selecting a color by clicking on an item of a web page, as disclosed by Knight, does *not* teach or suggest sending the identity of the corresponding color, ascertained by mapping a color image data signal produced from a scan to a defined color space.

The teaching in Knight of a purchaser manually selecting a color and communicating the manual selection of that color to a website would not have motivated a person of ordinary skill in the art to send the mapped color described in Kohler to a target output device. Kohler teaches a system that attempts to achieve consistent output among different types of output devices. On the other hand, Knight's teachings are completely different, and relate to user selection of color in making an online purchase. Objectively, a person of ordinary skill in the art would not have been motivated to combine the disparate teachings of Kohler and Knight to achieve the claimed

subject matter, as there clearly did not exist any teaching of any desirability to incorporate the subject matter of Knight (manual selection by a user in an online purchase) into Kohler. *See In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the *desirability* of the modification.”) (emphasis added).

In fact, the only basis for making the proposed combination of Kohler and Knight is impermissible hindsight benefiting from the disclosure of the present invention. *See In re Fritch*, 972 F.2d at 1266 (“It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious”); *see also, In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

Therefore, it is respectfully submitted that a *prima facie* case of obviousness has clearly not been established with respect to the subject matter of claim 1.

A further defect in the *prima facie* case of obviousness against claim 1 is that, even if the Kohler and Knight can be properly combined, that hypothetical combination does not teach or suggest all elements of claim 1. Note that claim 1 recites sending *the* identity of the corresponding color over a network to a website. Claim 1 does not recite sending an identity of the corresponding color over a network to a website. The element “the identity” refers to the identity of the corresponding color that is determined in the determining act of claim 1, where “the corresponding color” refers to the ascertained corresponding color based on mapping the color image data signal to a defined color space, and where the color image data signal is produced based on scanning an object. In other words, “the identity of the corresponding color” recited in claim 1 is *not* any identity of a color – claim 1 is very specific that the identity of the corresponding color is related to a color image data signal produced by scanning an object. Therefore, the citation of Knight as disclosing or suggesting the sending element of claim 1 is clearly erroneous, as Knight merely teaches that a user can click on a color to select a color for a product.

The Office Action conceded that Kohler fails to disclose the last clause of claim 1. As noted above, Knight also fails to disclose or suggest the sending act of claim 1. Therefore, the hypothetical combination of Kohler and Knight fails to disclose or suggest the sending of the identity of *the* corresponding color (ascertained from mapping the color image data signal produced by scanning an object to a defined color space) over a network to a shopping website for purchasing a product having the corresponding color. The *prima facie* case of obviousness is therefore defective for this additional reason.

Claims dependent from claim 1 are allowable for at least the same reasons. Moreover, in view of the allowability of claim 1 over Kohler and Knight, it is respectfully submitted that the rejections (including the obviousness rejections) of claims dependent from claim 1 have been overcome.

CLAIMS 14 & 28

Independent claim 14 was rejected as being obvious over Kohler and Ringland. It is respectfully submitted that a *prima facie* case of obviousness has also not been established with respect to claim 14 for at least the following two reasons: (1) no motivation or suggestion existed to combine the teachings of Kohler and Ringland; and (2) the hypothetical combination of Kohler and Ringland does not teach or suggest all elements of the claim.

The Office Action conceded that Kohler fails to disclose: in response to user selection, select a color region of the color image data signal representative of the object; determine a dominant color from a plurality of colors in the selected color region; map a portion of the color image data signal corresponding to the dominant color to the defined color space; and presenting the identity of the corresponding color to a user. 2/22/2006 Office Action at 8. The Office Action relied upon Ringland as disclosing the claimed features missing from Kohler. *Id.*

The Office Action cited to various passages in columns 19 and 20 of Ringland as disclosing these claimed features. *Id.* The cited passages of Ringland describe a paint matching window that contains a "Match Paint" button 702 for finding paints 706 that match the colors of any sample that has been marked for later use. The user is shown a color swath for each matching paint, along with the paint name, the manufacturer's number, and the page number in the manufacturer's book. These cited passages of Ringland refer to matching paints (note plural sense) to plural colors (note plural sense) of a sample. There is no indication or suggestion here,

or anywhere else in Ringland, of a computer determining a *dominant* color within a selected color region of a color image data signal that represents an object that has been scanned by a scanning apparatus, and mapping a portion of the color image data signal corresponding to the *dominant* color to the defined color space.

Clearly, neither Kohler nor Ringland even remotely suggest the determining a dominant color from a plurality of colors in a selected color region and mapping a portion of the color image data signal corresponding to the dominant color to the defined color space to ascertain an identity of the corresponding color. Therefore, a *prima facie* case of obviousness is defective because the hypothetical combination of Kohler and Ringland does not teach or suggest all elements of claim 14.

Moreover, it is respectfully submitted that there clearly did not exist any motivation or suggestion to combine the teachings of Kohler and Ringland. The cited portions of Ringland refer to matching paints to plural colors of a sample. On the other hand, Kohler relates to mapping a color point in a first color space of a first output device to a different color space for another output device. A person of ordinary skill in the art looking to the teachings of Kohler and Ringland clearly would not have been motivated to combine the disparate teachings of references to achieve the claimed invention. The *prima facie* case of obviousness is defective for this additional reason.

Amended independent claim 28 is allowable over Kohler and Ringland for similar reasons as claim 14.

Claims dependent from claims 14 and 28 are allowable for at least the same reasons. Moreover, in view of the allowability of base claims 14 and 28 over Kohler and Ringland, it is respectfully submitted that the obviousness rejections of dependent claims of claims 14 and 28 over Kohler, Ringland, and other references have also been overcome.

CLAIM 26

Independent claim 26 was rejected as being obvious over Kohler and Lee. The Office Action conceded that Kohler does not disclose the following elements: an object having a texture; processing the color image data to remove influence of the texture, the processing producing a de-texturized color image data; and mapping the de-texturized color image data to determine a corresponding color in a defined color space. 2/22/2006 Office Action at 10-11.

Again, the Office Action has conceded that Kohler fails to disclose a significant portion of the claimed subject matter. In attempting to remedy this defect of Kohler, the Office Action relied upon Lee as disclosing the missing claimed subject matter.

Again, a *prima facie* case of obviousness has not been established. Lee does mention that an object of interest can have texture, and that the texture of the object of interest can be removed. Lee, 6:58-61. However, in Lee, the goal of removing the texture of an object is for the purpose of creating a mask that identifies the size, shape, and location of the object of interest. Lee, 6:54-56. There is absolutely no suggestion whatsoever of processing a *color* image data to remove influence of texture, and producing a de-texturized *color* image data, and mapping the de-texturized *color* image data to determine a corresponding color in a defined color space, as recited in claim 26. In fact, Lee does not even use the word “color” in its disclosure. Therefore, it is respectfully submitted that the hypothetical combination of Kohler and Lee clearly fails to teach or suggest all elements of claim 26.

Moreover, there clearly did not exist any suggestion to incorporate the de-texturing feature of Lee into Kohler. As noted above, Kohler relates to mapping a color in one color space to a color in a different color space associated with corresponding different output devices. The mapping is performed by mapping a color point in one space to a different color point in another space. The issue of texturing clearly is not present in Kohler, and clearly there did not exist any suggestion of any desirability to perform de-texturing. In view of this, it is respectfully submitted that no motivation or suggestion existed to combine the teachings of Kohler and Lee to achieve the claimed subject matter.

In view of the foregoing, a *prima facie* case of obviousness has clearly not been established with respect to claim 26 and its dependent claims. In view of the allowability of claim 26 over Kohler and Lee, it is respectfully submitted that the obviousness rejection of dependent claim 27 over Kohler, Lee, and Knight has also been overcome.

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In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10004872-1).

Respectfully submitted,

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